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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,772	01/18/2000	Jeffrey W. Small	30566.86US01	1090

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EXAMINER

SHAH, SANJIV

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/484,772

Applicant(s)

SMALL, JEFFREY W.

Examiner

Sanjiv D. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,7-15,17-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 7-15, 17-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 5, 7-10, 12, 14, 15, 17-20, 22, 24, 25, 27-30, 32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Snyders (Patent # 5,982,996).

Regarding claim 5, 15, 25, Snyders teaches the claimed invention of associating multiple output device as shown in fig 1.

A computer with information (shown in fig 1, element 10) comprising a file generated by computer application (Col. 2, lines 12-14)

One or more printer (output device) configuration stored is shown in fig 9, element S7.24. Also see col. 2, lines 38-49.

Selecting information is shown in fig 7, element s3 and s6

Selecting one or more output device configuration is shown in fig 7, element s7 and col. 2, lines 38-49.

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Associating information with output device configuration (shown in fig 10, element S7.26) by saving an association between selected information and output device configuration with the file (See col. 2, lines 28-49, wherein Snyders teaches generating a output file and retrieving one or more printer configuration and providing the file to print processor, retrieving printer configuration, retrieving printer document properties, (i.e. file properties with the printer properties that is equivalent to claimed association saved in memory) saving the new properties in the registry).

Regarding claims 7, 8, 17, 18, 27, 28, Snyders shows a information to be printed as a graphics or drawing file as shown in fig 7, element S3.

Regarding claims 9, 19, 29, Snyders teaches the claimed invention of obtaining setting of the printer and associating it with the information as shown in fig 9, element S7.22, S7.23 and S7.26.

Regarding claims 10, 14, 20, 24, 30, 34, Snyders teaches the claimed information of saving the setting as shown in fig 9, element S7.24

Regarding claims 12, 22, 32, Snyder teaches a printer as shown in fig 1, element 14, 16 and 18.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 11, 13, 21, 23, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyders (Patent 5,982,996) in view of Marbry et al. (Patent # 5,692,111).

Regarding claim 11, 21, 31, Snyders teaches the claimed invention as described above with respect to claim 1. Snyders does teach multiple printers to select from as shown in fig 1 but does not specifically teach listing the printer configuration and presenting list of printers as claimed. Marbry et al. does. Specifically, Marbry et al. teaches the claimed

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invention of listing available printers as described in col. 3, lines 20-22, Presenting the configuration information is described in col. 3, lines 30-35 and selecting one printer for printing is described in col. 3, lines 63-65.

Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to include printer selection teachings of Marbry et al. in the method of Snyders because it provides easy access by organizing all available printer under one menu.

Regarding claims 13, 23, 33, Marbry et al. teaches selecting a printer whose configuration is not locally installed as described in col. 3, lines 25-30. This limitation is equivalent to claimed "none" selection as Marbry does teach obtaining the configuration and providing the access that is equivalent to selecting similar configuration.

Response to Arguments

6. Applicant's election with traverse of Group II in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the two inventions are not distinct and independent because they present similar inventive concept. This is not found persuasive because Group I claims a subject matter to associate different layout of drawings to different output device, that is to associate different portion of file to different output device, whereas Group II claims a subject matter to configure an output device. Both groups has separate utility and to configure an output device it is not required to

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associate different layout of drawings with different output device as claimed in Group I.

Therefore the two Groups are in fact distinct and independent and there is an additional burden on Examiner to search different inventions.

Applicant's arguments that two groups should not be restricted as argued in paper dated 9/8/2004 are not persuasive

Therefore the requirement is still deemed proper and is made FINAL.

Regarding art rejection applicant argues that neither Snyders nor Marby teach, disclose or suggest associating an output device configuration with a particular file of information that is generated by a computer application. As clearly cited in the office action, Snyder does teach association being saved as cited in col. 2, lines 28-49. The claimed invention does not specify association contents. Therefore the broadest reasonable interpretation of saving association is that both the files (output file from application and configuration file from the printer) are saved. Applicant further argues that saving step is different from registry saving because registry is not a file. Examiner disagrees.

Information or data is always saved in memory or registry device. File itself have to be stored in memory or registry. Therefore the arguments that the information is not stored in file are not persuasive. Also as described in col. 2, lines 28-49, Snyders does teach saving the output file with configuration information in the memory. It is inherent that the data is stored in a file in a memory. Therefore applicant's arguments are not persuasive.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (571) 272-4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanjiv D. Shah
Primary Examiner
Art Unit 2176

S. Shah
November 28, 2004